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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,548	12/13/2000	Uwe Schumann	BEIERSDORF 685-WCG	5636
7590 12/03/2003 Norris McLaughlin & Marcus, P.A. 220 East 42nd Street 30th Floor New York, NY 10017			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/736,548

Applicant(s)

SCHUMANN ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 and 4-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


ELIZABETH M. COLE
PRIMARY EXAMINER

NOTE

1. With respect to Applicants' question that "the applicants have not petitioned the finality of the rejection, ... it is unclear why: (1) the Examiner's Answer was not submitted; or (2) the Examiner's supervisor did not sign the final rejection." (Remarks, page 2, second paragraph), the Examiner has contacted Applicants' attorney Mr. Howard Lee on 11/19/2003 to apologize for the apparent administrative error, and forwarded an explanation that the prosecution was reopened in the interest of providing a secondary reference as evidence of the state of the art so as to make the prosecution complete, and agreed that the reasoning should have been included in the beginning of the Office Action, and also the Office Action should not have been made Final. The Examiner asked Attorney if there is any particular concern or suggestion for the next Office Action, as the Examiner is willing to treat the prior Office Action as Non-Final, and reconsider the application. Mr. Lee responded that he appreciates that the Examiner is trying to prosecute the case according to the rules of MPEP, he has no quarrel on the procedural matters, and he is only interested in getting an early conclusion. If the case is allowable, he is willing to make necessary further amendment, otherwise, since the work for appeal is already done, he would like to see an after-final Advisory, so as the case can move forward quickly. The Examiner would like to thank Mr. Lee's understanding of the Examiner's attempt as set forth above.

2. Applicants' response that "the fundamental basis for the applicants' arguments in the Appeal Brief was not that certain amines could not be hardeners but that to "pick

and choose" this element from the teachings of Kinzer requires two enormous leaps of selectivity which is not taught by Kinzer, i.e., first to specifically choose a hardener as an additional ingredient and then to choose yet again that this hardener will be amine" (Remarks, page 3, top paragraph) has been carefully considered, but is not persuasive. The Examiner repeats (see Paper No. 15, page 2, bottom paragraph) that Kinzer teaches that a plurality of epoxy resins including bisphenol A epoxy resins, cycloaliphatic epoxy resins, and aliphatic epoxy resins or mixtures can be used (column 2, lines 20-24). The epoxy coating compositions may also include hardeners (i.e., amines), etc. (column 6, lines 17-21). Clearly Kinzer's teachings is not limited to a plurality of epoxies, and encompasses the use of a epoxy component with hardeners, and Applicants have now appear to agree that hardeners could be certain amines, as set forth above. As to Applicants' argument that Examiner's reasoning as "pick and choose" specific hardener and specific amine, the Examiner repeats (see Paper No. 15, page 4) that Applicants' argument assumes that an anticipation rejection, not an obvious rejection, has been made. It should also be noted that, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute Kinzer's photo cured epoxy coating with an amine cured (or crosslinked) epoxy coating, as taught by Kinzer's disclosure of well known prior art, motivated by the desire to use a well known and commonly available crosslinked epoxy coating to improve the flexibility and toughness of the backing (Kinzer, column 4, lines 50-51).

3. Finally, Applicants' proposal to redraft the product claims into method claims dependent upon claim 8 has also been carefully considered. However, it appears that

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such redrafting is not deemed to place the application in better form for appeal or any effect to the products claims.